

Appl. No. 10/701,525

REMARKS

Claims 1-9 remain in the application. Claims 10-21 are withdrawn from consideration at this time.

The Examiner rejected claims 1-9 under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. More specifically, the Examiner indicated that some terms and expressions were unclear. Applicant respectfully disagrees with the Examiner.

First, the Examiner must consider the very recent *en banc* decision from the Federal Circuit (Phillips v. AWH Corp., Nos. 03-1269, 03-1286 (Fed. Cir. July 12, 2005), *en banc*), in which it is stated:

The claims, of course, do not stand alone. Rather, they are part of "a fully integrated written instrument," Markman, 52 F.3d at 978, consisting principally of a specification that concludes with the claims. For that reason, claims "must be read in view of the specification, of which they are a part." *Id.* at 979. As we stated in Vitronics, the specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." 90 F.3d at 1582.

This court and its predecessors have long emphasized the importance of the specification in claim construction. In Autogiro Co. of America v. United States, 384 F.2d 391, 397-98 (Ct. Cl. 1967), the Court of Claims characterized the specification as "a concordance for the claims," based on the statutory requirement that the specification "describe the manner and process of making and using" the patented invention. The Court of Customs and Patent Appeals made a similar point. See In re Fout, 675 F.2d 297, 300 (CCPA 1982) ("Claims must always be read in light of the specification. Here, the specification makes plain what the appellants did and did not invent . . .").

Appl. No. 10/701,525

Clearly, a person skilled in the art would understand, upon reading the specification, what is meant by "threshold current", "flowable conductor", "magnetic pressure forcing the conductor to flow" and "conductor core". That person would also understand what enables the flow to open the circuit. Therefore, Applicant submits that the terms and expressions used in claims 1-9 are clear, and thus meets the requirements of 35 U.S.C. §112, second paragraph. Reconsideration of Examiner's rejection is solicited.

The Applicant has made a minor amendment to claim 7 for reasons unrelated to the Examiner's rejections. The amendment was to correct a typographic error.

The Examiner rejected claims 1-2, 4-5 and 7-9 under 35 U.S.C. §103(a) as being allegedly obvious in view of US 5,831,507 to *Kasamatsu et al.* Applicant respectfully disagrees with the Examiner.

As indicated by the passage quoted by the Examiner, the Examiner must show the "subject matter as a whole" is taught by the prior art in order to sustain a proper cases for *prima facie* obviousness under §103(a). It is of course note sufficient to simply locate some features in the prior art. If at least one claim element is not taught by the prior art then the claim does not meet §103(a), and is thus allowable. A rejection that does not account for all claim limitations is inherently defective.

With respect, all of the Examiner's rejection under §103(a) suffers from this deficiency, as will now be detailed.

The Examiner identified figure 6 of *Kasamatsu et al.* as showing an element (5) [...] responsive to magnetic pressure applied thereto. Applicant disagrees with the Examiner interpretation of *Kasamatsu et al.* The Examiner must consider the teachings of *Kasamatsu et al.*, more specifically what is indicated at col. 6, lines 1-5:

In FIG. 6, a pair of leaf springs 13 are substituted for the lower coil spring 11 of the first embodiment and a pair of magnets 14a and 14b, which are attractive to each other, are

Appl. No. 10/701,525

substituted for the upper tension coil spring 12 of the first embodiment.

(emphasis added)

In the next paragraph, the Examiner indicated that *Kasamatsu et al.* does not disclose the magnetic pressure forcing the circuit to open. It is thus unclear why it would have been obvious to a person skilled in the art to arrive at the same invention using *Kasamatsu et al.* Clearly, *Kasamatsu et al.* does not teach the features of the claimed invention. Reconsideration of Examiner's rejection of claims 1-2, 4-5 and 7-9 is solicited.

Claims 1-9 are therefore allowable, and a Notice of Allowance is respectfully solicited.

In the event that there are any questions concerning this amendment or the application in general, the Examiner is respectfully urged to telephone the undersigned so that prosecution of this application may be expedited.

RESPECTFULLY SUBMITTED,

Date: August 23, 2005

By:



/Sébastien CLARK, Reg. No. 56,651

Agent of record

Tel: (514) 847-4259

Customer Number 32292
OGILVY RENAULT LLP (PWC)
1981 McGill College, Suite 1600
Montréal (Québec) Canada, H3A 2Y3

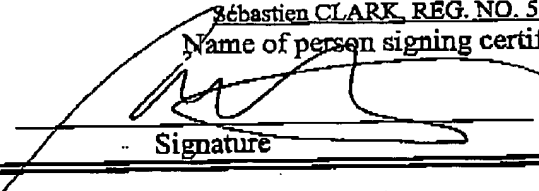
Appl. No. 10/701,525

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this response to the Official Action is being
facsimile transmitted to the
Patent and Trademark Office fax number (571) 273-8300 on the date
shown below.

Sébastien CLARK, REG. NO. 56,651

Name of person signing certification


SignatureAugust 23, 2005

Date